

**REMARKS**

Upon entry of the claim amendments, Claims 1-10 will be all the claims pending in the application.

Claim 1 has been amended to recite that the adhesive is coextensive with the at least one base film.

Amended Claim 1 is supported by the application as originally filed.

In this regard, the fundamental factual inquiry with respect to whether an amended claim is adequately supported by the application as filed is whether the amended claim defines an invention that was clearly conveyed to those skilled in the art at the time the application was filed. Ralston Purina Co. v. Far-Mar-Co., Inc., 227 USPQ 177, 179 (Fed. Cir. 1985). The subject matter of the amended claim need not be described literally, *i.e.*, using the same terms or *in haec verba*, in order for the disclosure to satisfy the description requirement. MPEP §2163.02.

The recitation in Claim 1 that the adhesive is coextensive with the at least one base film defines an aspect of the claimed water-permeable adhesive tape that was conveyed to those skilled in the art by, for example, the description at the paragraph bridging pages 8 and 9 of the specification and the description of the preparation of the adhesive tapes of Examples 1-5 at pages 10 and 11 of the specification. For example, one of ordinary skill in the art recognizes that the methods of preparing adhesive tapes disclosed at the paragraph bridging pages 8 and 9 of the specification encompass methods wherein the resulting adhesive of the adhesive tape is coextensive with the base film.

Claim 9 has been edited to ensure that it complies with the requirements of §112.

New Claim 10 is supported by the application as originally filed, including the description in the Examples at the first paragraph on page 13 of the specification.

No new matter has been added.

**I. STATEMENT OF SUBSTANCE OF INTERVIEW**

As a preliminary matter, counsel for Applicants wishes to thank the examiner for the opportunity to conduct an interview on November 29, 2005. The Statement of Substance of Interview is as follows:

(A) No exhibit was shown nor was a demonstration conducted.

(B) Claims 1-9 were discussed, especially Claims 1 and 9.

(C) U.S. Patent No. 5,229,185 ("Shiota") was discussed.

(D) The possibility of amending Claim 1 to recite that the adhesive is coextensive with the at least one base film was discussed. Also, the possibility of amending Claim 9 to recite a method of preparing semiconductor wafers and/or semiconductor-related materials for processing, comprising a step of affixing a semiconductor wafer or semiconductor material with the water-permeable adhesive tape according to Claim 1 prior to processing the wafer or material, was discussed.

(E) The general thrust of the principal argument was that the technical field of the presently claimed subject matter, which relates to the processing of semiconductor wafers and/or semiconductor related materials, is completely different from the technical field of speaker front sheets, as disclosed by Shiota. Furthermore, the problem to be solved by the presently claimed subject matter is completely different from the problem to be solved in the prior art.

(F) The other pertinent matter discussed was the definiteness of Claim 9.

(G) The examiner agreed to reconsider all issues upon the filing of a response.

**II. REJECTION UNDER 35 U.S.C. § 103**

Referring to Section Nos. 2 and 5-6 at pages 2-4 of the final Office Action, Claims 1-3 and 5-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiota.

Independent Claim 1 is not rendered obvious by Shiota.

A feature of the water-permeable adhesive tape of Claim 1 is that the adhesive is coextensive with the at least one base film.

Shiota does not teach or suggest the above feature. Instead, the adhesive layer 3 of Shiota merely “extends along a peripheral portion of the perforated sheet.” Applicants refer to column 2, lines 45-47, and FIG. 1. There is no plain adhesive layer in Shiota; there is only a perforated adhesive sheet having at one side a gauze material and at the other side an adhesive only at the edges.

Furthermore, a modification to Shiota that would extend the adhesive layer beyond the peripheral portion of the perforated sheet, *i.e.*, that would cause the adhesive layer to be coextensive with the perforated sheet, is impermissible because it would destroy the teachings of Shiota and render the speaker front sheets unsatisfactory for their intended purpose. In particular, an adhesive layer that extends only along a peripheral portion of the perforated sheet is a necessary and essential element of Shiota. As stated at column 2, lines 45-48, the adhesive layer extends only along a peripheral portion of the perforated sheet “so as not to hinder passage of sound waves through the speaker front sheet.”

Each of Claims 2-9 is also not rendered obvious by Shiota, at least by virtue of its dependence from Claim 1.

Independent Claim 10 is also not rendered obvious by Shiota.

A feature of the water-permeable adhesive tape of Claim 10 is that the adhesive has a semiconductor wafer or a semiconductor material affixed thereto.

Shiota does not teach or suggest the above feature.

The technical field of the subject matter of Claim 10, which relates to the processing of semiconductor wafers and/or semiconductor related materials, is completely different from the technical field of speaker front sheets, as taught by Shiota. The problem to be solved by the subject matter of Claim 10 is also completely different from the problem to be solved in Shiota. Shiota’s complete silence with respect to semiconductor wafers and/or semiconductor related

materials precludes it from providing the necessary suggestion which would motivate one of ordinary skill in the art to affix a semiconductor wafer or a semiconductor material to an adhesive layer of Shiota.

For the foregoing reasons, Applicants request reconsideration and withdrawal of the §103 rejection of Claims 1-3 and 5-9.

### **III. REJECTION UNDER 35 U.S.C. § 103**

Referring to Section No. 3 at pages 2 and 3 of the final Office Action, Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiota in view of JP 9-272850 (“JP ‘850”).

Claim 4 depends from Claims 1 or 2, such that this rejection is directed to a dependent claim only. As noted at Section II of this Amendment, Shiota does not suggest the water-permeable adhesive tape of Claim 1 (Claim 2 also depends from Claim 1). JP ‘850 does not cure the deficiencies of Shiota identified at Section II. Accordingly, Applicants respectfully request reconsideration and withdrawal of the §103 rejection of Claim 4.

### **IV. REJECTION UNDER 35 U.S.C. § 112**

Referring to Section Nos. 4 and 7 at pages 3 and 4 of the Office Action, Claim 9 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Amended Claim 9 is directed to a method of preparing semiconductor wafers and/or semiconductor-related materials for processing. According to amended Claim 9, the method comprises a step of affixing a semiconductor wafer or semiconductor material with the water-permeable adhesive tape according to Claim 1 prior to processing the wafer or material.

As acknowledged by the examiner during the interview, amended Claim 9 may be definite. Accordingly, withdrawal of the §112 rejection of Claim 9 is requested.

### **IV. CONCLUSION**

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the examiner feels may be

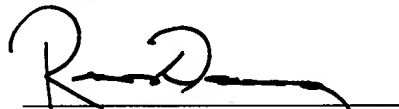
AMENDMENT

U.S. Appln. No. 09/818,936

best resolved through a personal or telephone interview, the examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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**23373**

CUSTOMER NUMBER

Date: February 22, 2006